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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,279	04/20/2004	Christopher B. Best	20003.0080	2647

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/827,279

Applicant(s)

BEST, CHRISTOPHER B.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8,10-13 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8,10-13,19 and 20 is/are allowed.
- 6) ☒ Claim(s) 22-25 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office action is responsive to communication received 06/23/2006 –  
Amendment.

Claims 9 and 14-18 have been canceled, as directed.

Claims 1-8, 10-13 and 19-25 remain pending.

Following is an action on the MERITS:

#### ***Allowable Subject Matter***

Claims 1-8, 10-13, 19 and 20 are allowable over the prior art references of record in view of the arguments set forth on page 5, lines 10-23 along with page 6, lines 10-14 of the remarks, received 06/23/2006.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Rohrer ('807). With reference to Figures 1 and 4, note body member (1), face member (38) and dampening members (17, 19). As the dampening member at the center is diverse from the dampening member located at the heel and toe, it is deemed that the dampening member is comprised of "different materials in toe, center and heel portions thereof", as broadly as claimed.

#### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrer ('807). Although the specific thickness of the dampening member in Rohrer is not detailed, one of ordinary skill in the art would have found it obvious to dimension the dampening member based in part on the actual size of the putter head. Moreover, the patent to Rohrer indicates that the dampening members are shaped, arranged and sized to provide a desired energy absorption. See col. 4, lines 4-22. As to the specific materials required by claim 24, these materials would appear to fall within the broad category of viscoelastic materials that Rohrer mentions, even though no specific material for the vibration absorbent materials in Rohrer is depicted. One of ordinary skill in the art would have found it obvious to select a suitable material based upon the amount of energy absorption required. Moreover, the applicant has not invented the claimed materials. It has long been established that the selection of a known material to take advantage of the known properties of said material would have been obvious to one of ordinary skill in the art. See *In re Hopkins* 145 USPQ 140. As to claim 25, Rohrer broadly indicates that the elastomeric portions of the head may be partially or fully encased by the club head material for appearance purposes (col. 5, lines 43-50). As such, the skilled artisan would have found it obvious to modify the Rohrer device by

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providing that the dampening members be visible to a user at address, the motivation being to enhance the outward look of the head.

### ***Claim Objections***

Claim 21 is objected to because of the following informalities: The claim would appear to be phrased as an incomplete sentence. Appropriate correction is required.

Claim 21 is objected to as being dependent upon a rejected base claim, but based upon its dependence of claim 1, now indicated as allowable, would likewise be allowable if rewritten to correct the apparent minor informality indicated, *supra*.

### ***Further references of interest***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Figure 14 in Rohrer ('997).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.Passaniti/sp  
August 31, 2006

  
Sebastiano Passaniti  
Primary Examiner